

REMARKS

Claims 1-18 are pending. Claims 1-18 are rejected. No new matter has been added.

STATUS

Applicants note that the pending office action is indicated as being responsive to communications filed on February 17, 2006. Applicants believe this office action to be the first communication from the USPTO since the initial filing of the application, and request clarification as to which communications the pending office action are in response to.

35 U.S.C. 103(a) Rejections

Claims 1-3, 5-8, and 11-18 are rejected under 35 U.S.C. § 103(a) as being obvious over Muntz, U.S. Patent No. 6,141,348.

The Examiner is respectfully directed to independent Claim1, which recites that embodiments of the present invention are directed to:

A method for generating a modified packet for output from a router, comprising:
 storing a received packet in a first memory;
 computing modified bytes corresponding to said packet;
 storing said modified bytes in a second memory;
 multiplexing select unmodified bytes corresponding to said packet stored in said first memory with said modified bytes in said second memory to generate said modified packet.

Claims 5 and 15 recite similar limitations. Claims 2-3 are dependent upon Claim 1, and recite further features of the claimed embodiments. Claims 6-8 and 11-14 are dependent upon Claim 5, and recite further features of the claimed embodiments. Claims 16-18 are dependent upon Claim 15, and recite further features of the claimed embodiments.

The present rejection suggests that Muntz describes every element of the embodiment recited in Claim 1. Applicants respectfully disagree, and assert that Muntz fails to teach or suggest computing modified bytes corresponding to said packet, as claimed. Applicants further contend that Muntz fails to teach or suggest storing said modified bytes in a second memory. Applicants additionally contend that Muntz fails to teach or suggest multiplexing select unmodified bytes corresponding to said packet stored in said first memory with said modified bytes in said second memory to generate said modified packet, also as claimed. Finally, Applicants assert that the rejection fails to set forth a *prima facie* case for obviousness under 35 U.S.C. § 103(a).

Applicants have reviewed Muntz, and understand it to purport to describe a system for quickly extracting information from arbitrary fields of a packet (col. 2, ln. 66-67). To this end, Muntz suggests the use of one or multiplexers coupled to programmable bit number processors (col. 4, ln. 41-47), which extract one bit each per clock cycle, until the desired number of bits have been extracted (col. 2, ln 53-61; *see also* col. 5, ln. 65 - col. 6, ln. 22).

The rejection suggests that Muntz discloses storing a packet in memory (col. 4, ln. 68). Applicants agree.

The rejection then states that Muntz describes "reading selected fields into a RAM/lookup table and using 'control field contents' determined in accordance with this procedure wherein the contents are 'perform(ed) to the data packet'" (pg. 2, § 2). Applicants request clarification of this point. If, as Applicants assume, the rejection is equating this operation of Muntz to the claimed behavior of computing modified bytes corresponding to the packet, applicants respectfully disagree. The cited portion of Muntz describes using the

result of the data extraction to reference a lookup table, where the lookup table describes functions that networking equipment should perform on the data packet; what functions are to be performed, Muntz does not describe. Accordingly, Muntz doesn't suggest computing modified bytes corresponding to the packet, as claimed.

Applicants also request clarification, regarding the claimed element of storing the modified bytes in a second memory. Applicants do not read Muntz to suggest this behavior, and the present rejection is silent on this element.

The present rejection then states "it is not explicitly stated that the multiplexer which is used to select the data bits is used to apply the 'perform(ed) operation', the examiner believes that one of ordinary skill in the art at the time of the invention would have recognized that it would be useful to have it perform the demultiplexing operation of inserting the 'looked up' values back into the packet as well in order to save the cost of duplicating and using additional hardware" (pg. 2, § 2). Applicants request clarification of this point. If, as Applicants assume, the rejection is suggesting combining Muntz with some teaching or knowledge of the art to describe the claimed behavior of multiplexing select unmodified bytes corresponding to said packet stored in said first memory with said modified bytes in said second memory to generate said modified packet, Applicants respectfully disagree.

The multiplexers of Muntz are described solely as being used for extracting bits from arbitrary fields in a packet (*see, e.g.*, col. 6, ln. 10-22). Nowhere does Muntz suggest using them for another purpose, such as inserting bits back into the packet. Moreover, given the

described behavior of Muntz' system, it appears unlikely, barring some additional reference, that these same multiplexers could be used for this purpose.

Further, the lookup tables described in Muntz contain control field contents, for instructing network hardware to perform functions on a data packet (col. 7, ln. 6-12). Such contents would not be inserted into the packet in any case.

Finally, Applicants assert that the rejection fails to present a *prima facie* case of obviousness, under 35 U.S.C. 103. The rejection suggests, without attribution, that "the examiner believes that one of ordinary skill in the art at the time of the invention would have recognized that it would be useful to have it perform the demultiplexing operation of inserting the 'looked up' values back into the packet as well in order to save the cost of duplicating and using additional hardware" (pg. 2, § 2). Applicants respectfully disagree. Applicants also respectfully contend that this is a mischaracterization of the test for obviousness under 35 U.S.C. § 103.

Applicants note that "(t)he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant also notes that "(t)he level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Applicants respectfully submit that the rejection is using impermissible hindsight, by utilizing the language of the claim as a blueprint to collect references and then devise a motivation for combining them, where no suggestion or motivation exists in the

references cited. Applicants therefore request that the Muntz reference be withdrawn, or that a citation to the purported motivation to combine be provided.

Therefore, Applicants respectfully contend that Muntz fails to anticipate or render obvious the embodiments of the present invention recited in Claims 1, 5, and 15.

Accordingly, Applicant respectfully contends that Claims 1, 5, and 15 overcome the basis for rejection under 35 U.S.C. 103(a), and are in condition for allowance. Therefore, Claims 2-3, dependent upon Claim 1, Claims 6-8 and 11-14, dependent upon Claim 5, and Claims 16-18, dependent upon Claim 15, also overcome the basis for rejection, as being dependent upon an allowable base claim.

Claims 4 and 9-10 are rejected under 35 U.S.C. 103(a) as being obvious over Muntz, in view of Belz et al., U.S. Patent No. 6,980,552.

The Examiner is respectfully directed to independent Claim 1, reproduced above. Claim 5 recites similar limitations. Claim 4 is dependent on Claim 1, and recites further features of the claimed embodiments. Claims 9-10 are dependent on Claim 5, and recite further features of the claimed embodiments.

Applicants respectfully assert the above-presented arguments, regarding Claim 1 and Muntz. Belz fails to remedy these defects in Muntz, as Belz does not teach or suggest computing modified bytes corresponding to said packet, storing said modified bytes in a second memory, and multiplexing select unmodified bytes corresponding to said packet stored in said first memory with said modified bytes in said second memory to generate said modified packet, as claimed.

Therefore, Applicants respectfully contend that Muntz, alone or in combination with Belz, fails to anticipate or render obvious the embodiments of the present invention recited in Claims 4 and 9-10. Accordingly, Applicant respectfully contends that Claims 4 and 9-10 overcome the basis for rejection under 35 U.S.C. 103(a), and are in condition for allowance.

Conclusion

In light of the above-listed amendments and remarks, Applicants respectfully request allowance of the remaining Claims.

The Examiner is urged to contact Applicants' representative William P. O'Meara at 970-898-7917, if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

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James P. Hao
Reg. No. 36,398
Two North Market Street
Third Floor
San Jose, California 95113
(408) 938-9060